

I. Formalities

The Draftsperson objects to the drawings under 37 C.F.R. § 1.84(l) for allegedly poor line quality. As shown in the attached Letter to Draftsperson Submitting Formal Drawings, Applicant respectfully submits that the formal drawings overcome the Draftsperson's objections. Accordingly, Applicant respectfully requests withdrawal of the Draftsperson's objections.

The Office Action indicates that an initialed copy of form PTO-1449 has been provided in response to the Information Disclosure Statements filed by the Applicant on February 16, 2000 and June 19, 2000. However, the Patent Office has not provided an initialed copy of Form PTO-1449 for the Information Disclosure Statement submitted on January 8, 1999. Accordingly, Applicant respectfully requests that the Examiner provide an initialed copy of Form PTO-1449 for the above-identified application in the next Office Action.

II. Claims 1-13 Are Novel under 35 U.S.C. § 102

Claims 1-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated over Grisham (U.S. Patent No. 4,739,128). Applicant respectfully submits that Grisham fails to disclose all of the features recited in claims 1-13, as required under §102(b). Thus, Applicant respectfully requests withdrawal of the rejection.

The present invention relates to a portable communication apparatus. As illustrated in application Figure 1, a main body 100 has a first part having arrow keys 103 and an enter key 104, and a second part having a keypad 102 with a ten-key pad and a menu key 105. An antenna 108 permits wireless communication, and an LCD display 101, battery pack 109, speaker 106 and microphone 107 are also provided. The speaker 106 and the microphone 107 are on the same side of the main body 100 as the first part and the second part. As illustrated in application

Figures 7 and 8A-8B, a stick lever 601 may be used instead of the arrows keys 103 and the enter key 104. Accordingly, a user can navigate through series of options, such as a directory or phone settings, without substantial movement of the user's finger.

Figure 6 of Grisham discloses a thumb-controlled, hand-held joystick with a housing 15 having an LCD display screen 51 navigable via a manipulandum 50, the structure of which is illustrated in Figure 4 of Grisham. Figure 5 of Grisham illustrates four independent keys forming a manipulandum 29 for a housing 10 that can provide navigational support. Grisham does not disclose an enter key. Grisham discloses a manipulandum configured for navigation but not for execution. Applicant respectfully submits that column 2, lines 19-22 merely describes the manner in which the joystick of Grisham navigates, and does not disclose selection or execution. Further, the joystick of Grisham is capable of moving in various directions to select an item, but Grisham does not disclose executing an item by depressing the joystick. As illustrated in Figure 6 of Grisham, the shape of the phone requires the speaker or microphone to be on a side of the housing opposite the display for a user to operate the phone.

Applicant respectfully submits that Grisham fails to disclose all of the features recited in claims 1-13, as required under §102. For example, Grisham fails to disclose "at least one key used to select a desired information item from a plurality of information items displayed in the display and execute a selected information item" as recited in independent claim 1. Grisham also fails to disclose "a plurality of key contacts which are used to select a desired information item from a plurality of information items displayed in the display and then to execute a selected information item" as recited in independent claims 6 and 10. As noted above, Grisham discloses navigating between items in a display, but does not disclose selecting and executing an

information item. Further, Grisham does not disclose a display and a transmitter on the main side of the housing as recited in claims 1, 6 and 10. As noted above, the shape of Grisham requires the microphone and speaker on a different side of the phone from the manipulandum.

Claims 2-5 depend from claim 1, claims 7-9 depend from claim 6 and claims 11-13 depend from claim 10. Applicant respectfully submits that the dependent claims are allowable for at least the reasons discussed above with respect to the independent claims. Applicant also respectfully submits that Grisham fails to disclose “an execution key disposed at a position sandwiched by the plurality of movement operation keys, that executes the selected information item,” as recited in dependent claims 2, 8 and 12. Further, Applicant respectfully submits that Grisham fails to disclose “a joystick-type key, which is inclined in a desired search direction to select the desired information item and is depressed to execute the desired information item,” as recited in claim 4, or “a joystick-type key, which is inclined in a desired search direction to turn on a movement operation key contact corresponding to the desired search information and is depressed to turn on the execution key contact” as recited in claims 9 and 13. Thus, Applicant respectfully requests withdrawal of the rejection under §102(b).

III. Claims 1-13 Would Not Have Been Obvious Under 35 U.S.C. § 103

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Japanese Patent 6232992 (hereafter “JP ‘992”) in view of Grisham. Applicant respectfully submits that the cited references, either alone or in combination, fail to disclose or suggest all of the features recited in claims 1-13, as required to establish a prima facie case of obviousness under §103(a). Thus, Applicant respectfully requests withdrawal of the rejection.

JP '992 discloses a telephone receiver capable of controlling an electronic computer. A telephone receiver 103 having a separate electronic computer 101 is configured to select icons 106-108 on a separated display device. Track balls 104, 105 project from a surface of the telephone receiver 103 such that a user can navigate and select with arrow keys 402-405 and a central key 406, as illustrated in Figures 2 and 4 of JP '992. As admitted by the Patent Office, JP '992 fails to disclose a display on a main side of the housing.

Applicant respectfully submits that the proposed combination of references fails to disclose or suggest all of the features recited in claims 1-13. For example, as admitted in the Office Action, JP '992 fails to disclose or suggest a display on the main side of the housing, as recited in claims 1, 6 and 10. Further JP '992 fails to disclose or suggest a transmitter on the main side as recited in claims 1, 6 and 10.

Grisham fails to cure the deficiencies of JP '992 to produce the features recited in claims 1-13. For example, Grisham fails to disclose or suggest a transmitter positioned on the main side as recited in claims 1, 6 and 10. Figure 6 of Grisham does not disclose a speaker and a display on the same side, as recited in claims 1, 6 and 10, because such a configuration would destroy the functionality of Grisham, as the joystick of Grisham would obstruct the user's ear from the speaker or transmitter. Applicant respectfully submits that no motivation is disclosed or suggested for combining Grisham into Japanese '992 to produce the features recited in claims 1, 6 and 10. As noted above, the shape of the phone disclosed in Grisham requires the transmitter to be on a side opposite the display for the user to operate the phone. Thus, Applicant respectfully submits that Grisham fails to cure the deficiencies of Japanese '992.

Claims 2-5 depend from claim 1, claims 7-9 depend from claim 6 and claims 11-13 depend from claim 10. Applicant respectfully submits that the dependent claims are allowable for at least the same reasons discussed above with respect to their independent claims. Thus, Applicant respectfully requests withdrawal of the rejection under §103(a).

IV. New Claims 14-30 Are Allowable

As shown in the foregoing Amendments, Applicant has added new claims 14-30. Applicant respectfully submits that new claims 14-30 are allowable for at least the same reasons discussed above. For example, independent claim 14 recites a communication device, comprising “a first user interface and a second user interface positioned on a first side of said housing ... wherein said first portion [of an input device] enables a user to select an item from said first user interface and execute a task in accordance with said item, said first user interface comprising a display,” which recitation is neither disclosed nor suggested by the references of record, as discussed above. Claims 15-23 depend from claim 14, and are allowable for at least the same reasons as claim 14, as well as the reasons discussed above. Additionally, new independent claim 23 recites a method for performing a task in a communication device that is not disclosed or suggested by the references of record. Claims 25-30 depend from claim 24. Applicant respectfully submits that the references of record fail to disclose or suggest the features recited in claims 14-30. Accordingly, Applicant respectfully requests allowance of new claims 14-30.

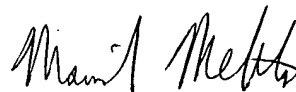
III. Conclusion

Reconsideration and allowance of all claims are respectfully requested in view of the foregoing amendments and remarks. In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below.

Filed concurrently herewith is an Excess Claim Fee Payment Letter (with fee) for the excess claims produced by this Amendment.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,



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